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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,937	04/14/2000	Michael B Chancellor	28682-501-CIP	9119

7590 03/15/2006

Leslie A. Serunian, Ph.D  
MINTZ LEVIN COHN FERRIS GLOVSKY  
Chrysler Center  
666 Third Avenue 24th Floor  
New York, NY 10017

EXAMINER

WHITEMAN, BRIAN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 09/549,937	Applicant(s) CHANCELLOR ET AL.	
	Examiner Brian Whiteman	Art Unit 1635	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 06 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: 220 and 222.  
Claim(s) objected to: None.  
Claim(s) rejected: 107, 110-112, 114, 154, 157-161, 163, 166-170, 173-180, 190, 193-197, 199-201, 204-206, 209-211, 216-219, 221, 223-229  
Claim(s) withdrawn from consideration: None.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

**BRIAN WHITEMAN**  
**PATENT EXAMINER**

*Brian Whiteman*

Continuation of 3. NOTE: The proposed amendment to claims 190, 197 and 206 would require further consideration and search.

Continuation of 11. does NOT place the application in condition for allowance because: The argument against the 112 second paragraph is moot because the argument is based on a proposed amendment that was not entered.

In response to applicant's argument on pages 13-14 that the preplating method in the specification is an exemplary teaching of the claimed invention, the argument has already been addressed in the office action mailed on 1/5/06 (See pages 2-5).

In response to applicant's arguments (pages 13-15) that one having skill in the pertinent art would understand that the adherent cell confluency ranges stated in applicant's specifications are disclosed by way of example only and predictability of re-plating of non-adherent cells after a muscle cell suspension is plated, the arguments are not found persuasive because other than applicant's assertions there is no evidence of record to support applicant's assertions. See *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

In response to applicant's argument that in view of *Bilstad v. Wakalopoulos*, 72 USPQ2d 1785 (Fed. Cir. 2004) and *Capon v. Eshhar*, 76 USPQ2d 1078 (Fed. Cir. 2005) disclosure of a single species may be sufficient written description to support a later claimed genus, including the species, the argument is not found persuasive because each invention is based on its own merits and disclosure of a single species may be sufficient to support a claimed genus. See *In re Giolito*, 530 F.2d 397, 400, 188 USPQ 645, 648 (CCPA 1976). The claimed invention is directed to a biological invention not a mechanical invention as discussed in *Bilstad*. Furthermore, the specification of '896 indicates that the preplating method produced a result that was unpredictable. See page 67 of appln. no. 09/302,896. See *In re Wertheim* 541 F. 2d 257, 191 USPQ (CCPA 1976).